



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,279	07/28/2003	Kenneth M. Kan	1700-003P/FLS	4719

22831 7590 07/07/2004

SCHWEITZER CORNMAN GROSS & BONDELL LLP
292 MADISON AVENUE - 19th FLOOR
NEW YORK, NY 10017

EXAMINER

FIGUEROA, FELIX O

ART UNIT	PAPER NUMBER
----------	--------------

2833

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/628,279	Applicant(s) KAN ET AL.	
	Examiner Felix O. Figueroa	Art Unit 2833	

-- Th MAILING DATE of this communication appears on th cov r sheet with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 6-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-9,12 and 13 is/are allowed.
- 6) ☒ Claim(s) 1,2,4,10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Sawada et al. (US 6,315,611).

Sawada discloses a plug-in lamp socket comprising: a socket body (20) formed of insulating material; laterally spaced apart contact clips (40) mounted by said socket body; the contact clips being formed of conductive metal having resilient characteristics, and being of generally u-shaped configuration defined by spaced apart contact side walls (not labeled) and a wall connecting the contact side walls; the contact clips being mounted by the socket body and being positioned to receive and resiliently grip contact elements; the contact side walls having inwardly protuberant retention elements (38,39).

Regarding claim 2, Sawada discloses the contact side walls having first (38) and second (39) inwardly protuberant retention elements; the second retention elements being positioned below said first retention elements.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 2833

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sawada in view of Ruehleemann (U 3,192,498).

Sawada discloses substantially the claimed invention except for the form of the retention elements. Ruehleemann shows that retention elements in the form of dimples are an art recognized equivalent structure for the retention elements of Sawada. Therefore, because these two retention elements were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute of the dimples of Ruehleemann for the retention elements Sawada to provide a sturdy retention element.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sawada in view of Fielding (US 746,488).

Sawada discloses substantially the claimed invention except for vertical opening and the mounting screw. Fielding teaches a lamp socket formed with a vertical opening along it central axis with a screw to attached the socket to a support while maintaining a low profile. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the socket of Sawada with a vertical opening to accommodate a screw, as taught by Fielding, to attached the socket to a support while maintaining a low profile.

Allowable Subject Matter

Claims 6-9,12 and 13 are allowed.

Response to Arguments

Applicant's arguments filed May 3, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that Sawada does not disclose retention elements but merely contact elements, please note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In response to Applicant's arguments that Sawada lacks "the U-shaped contact clips hav[ing] opposed inwardly protuberant retention elements positioned to lie closely above and closely below planar portion of the lamp contact elements", please note that the protuberant retention elements (38,39) oppose protuberant elements on the other leg of the U-shaped contact (which is not shown in Fig.4).

In response to applicant's argument (regarding claim 2) that the elements 38 and 39 do not serve either a retention or a limiting purpose, it is again noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In response to applicant's argument (regarding claim 4) that the first retention element [is] to be engaged and temporally outwardly displaced during plug-insertion", it is again noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In response to applicant's argument that "it is not clear from the disclosures of either Sawada et al. or Ruehleemann just how and where they would be located or what their function would be", it is noted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Ruehleemann show the use of dimples as an alternative to the protrusion elements of Sawada. Additionally, it is again noted that the intended use/function of an element cannot differentiate from an element meeting the claimed structural limitations.

In response to applicant's argument regarding claim 11, please note that a recitation of the intended use (used for mounting a lamp having an oriented output beam) of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed

invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Additionally, regarding Applicant's argument that "the illustrated forms of the Fielding device appear to preclude any rotational re-positioning of the socket, inasmuch as there is a form of tongue and groove alignment arrangement that fixes the orientation of the socket, so rotational adjustment would not be possible", please note that the structure of Fielding allows for at least an 180 degree repositioning. Nonetheless, it is noted that the use of the device of Fielding in combination with a different base (i.e. on without the ridge) would allow a wider range for repositioning.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


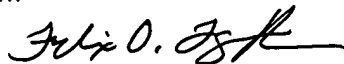
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felix O. Figueroa whose telephone number is (571) 272-2003. The examiner can normally be reached on Mon.-Fri., 10:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (571) 272-2800 Ext. 33. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ffr



P. AUSTIN BRADLEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800